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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,221

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Joel Hanson

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EXAMINER

WOO, STELLA L

VERIZON

PATENT MANAGEMENT GROUP

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SUITE 500

ARLINGTON, VA 22201-2909

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,221	Applicant(s) HANSON ET AL.	
	Examiner Stella L. Woo	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 16-19 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-13, 18, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogard (US 6,757,365 B1) in view of Shaffer et al. (US 7,031,268 B1, hereinafter "Shaffer") for the same reasons applied to claims 1-6, 8-13, 18, 24 in the last Office action and repeated below.

Bogard discloses a method for establishing communications between a calling party using a telephone connection (caller at telephone 300 or 301; col. 5, lines 32-41) and a called party using an instant messaging client (called party at computer 302 with an instant messaging service; col. 5, lines 55-67), comprising:

receiving a telephone call connection request from the calling party (telephone caller requests a voice connection via voice portal 310; col. 8, lines 25-33); and

establishing end-to-end voice communications between the telephone connection and the instant messaging client (computer user selects to establish the IM voice protocol session with the telephone caller; col. 8, lines 33-44).

Bogard differs from claims 1 and 18 in that the called party is identified by the called party's IM username (e.g. "Buddy1") rather than using a telephone number to retrieve the instant messaging identifier. However, Shaffer teaches that it is well known to have a caller identify a called party by the called party's telephone number, and then using the telephone number to retrieve an IM identifier corresponding to the telephone number (Figure 9B, step 900; Figure 18A, step 1806; col. 6, lines 16-21, 47-65). It would have been obvious to an artisan of ordinary skill to incorporate such use of a telephone number to identify an IM user, as taught by Shaffer, within the method of Bogard in order to simplify the process of identifying a called party by using the called party's telephone number rather than having to remember the called party's IM username.

Regarding claims 2-5, in Bogard, the user's instant messaging client supports voice communication with a voice telephone caller by translating between telephone audio and IM voice protocol format (col. 8, lines 33-44).

Regarding claim 6, in Bogard, a telephone caller requests a telephone connection with a logged in IM user (col. 8, lines 1-33).

Regarding claim 8, in Bogard, a user profile can include privacy settings, limits to callers from a buddy list, etc. (col. 11, lines 12-18; col. 12, lines 1-23).

Regarding claim 9, in Bogard, user's profile information indicates when a user's IM software can support voice communications (col. 8, lines 45-57).

Regarding claim 10, in Bogard, IM server 308 also determines if the user is currently online and able to receive the voice communication (col. 7, line 47 – col. 8, line 44).

Regarding claims 11, 24, in Bogard, IM server 308 determines the called party's response to a prompt asking whether or not he/she wishes to accept the incoming call (col. 8, lines 29-44).

Regarding claim 12, in Bogard, the end-to-end voice communication is established via telephony gateway 307 and voice portal 310 (Figure 3).

Regarding claim 13, in Bogard, telephony gateway 307 interfaces between telephone network 304 and Internet 306 (Figure 3).

3. Claims 16-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bogard and Shaffer, as applied to claims 1 and 18 above, and further in view of Diacakis (US 2002/0120774 A1) for the same reasons given in the last Office action and repeated below.

The combination of Bogard and Shaffer differs from claim 16 in that it does not specify the instant message identifier as corresponding to a time period designated for contacting the called party. However, Diacakis teaches the desirability of associating with an instant messaging identifier a time period during which the individual is present on the networks available to him, for example, instant messaging (paragraphs 39, 58) such that it would have been obvious to an artisan of ordinary skill to incorporate such association of a time period with an instant messaging identifier, as taught by Diacakis, within the

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combination of Bogard and Shaffer in order to contact the called party using instant messaging during the time period in which the party can be reached by instant messaging.

Regarding claims 17 and 19, Diacakis teaches an alias (e.g. Jonathan; Figure 8) for uniquely identifying the called party in an instant messaging environment among a plurality of instant messaging environments (note two instant message domain names in Figure 8) and destination information specifying one or more communication devices for reaching the called party (note voice telephone numbers and email addresses in Figure 8).

4. Applicant's traversal of the restriction requirement in the reply filed on March 16, 2006 is acknowledged. The traversal is on the grounds that the search and examination can be made without serious burden because there are "overlapping search areas." This is not found persuasive.

Newly added claims 20-23 recite a method in which the call treatment performed includes leaving a voice message or a facsimile message to the called party such that claims 20-23 are classified in Class 379, subclass 88.13. Contrary to applicant's remarks, the search area for claims 1-6, 8-13, 16-19 do not include Class 379, subclass 88.13, and the search area for claims 20-23 do not include 379, subclasses 93.24 and 90.01. Moreover, the steps recited in method claims 20-23 are not recited in method claims 1-19, and vice versa. Therefore, the examination of claims 20-23, drawn to an invention distinct from claims 1-6, 8-13, 16-19, would require a serious burden on the part of the

examiner. The requirement is still deemed proper and is therefore made FINAL.

Applicant is reminded that a complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

5. Applicant's arguments filed August 2, 2006 have been fully considered but they are not persuasive.

Applicant argues that “remembering a called party’s IM username, which typically has some semblance to the user (e.g., the user’s actual name), is more simple than remembering a telephone number.” The examiner disagrees. A calling party who is unfamiliar with a called party’s self-chosen username cannot possibly guess as to what username the called party has selected. However, a calling party who desires to place a telephone call to a called party can easily obtain the exact telephone number needed to contact the called party. Applicant further argues that “[a]t not point does *Bogard* even imply that a computer user 302 is near a telephone.” However, the association of a user’s telephone number with the user’s IM username has nothing to do with the physical locations of a telephone and computer user. Moreover, it is *Shaffer* which is relied upon for teaching the desirability of retrieving a user’s IM username based on the user’s telephone number.

6. Applicant further argues that “*Shaffer et al.* uses an IM service as a means to invite someone to join an ongoing conference. This mode of communication is distinct from the end-to-end voice communication that occurs later over a media transport channel. Notably, the IM communication occurs over a channel unable to support end-to-end voice communications between the calling and called parties.” However, applicant is reminded that it is *Bogard*, not *Shaffer et al.*, which was relied upon for teaching IM communication over a channel which supports end-to-end voice communication between calling and called parties. Again, *Shaffer et al.* was relied upon for its teaching of retrieving a user’s IM username based on the user’s telephone number. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only

from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Friday, 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Stella L. Woo
Primary Examiner
Art Unit 2614